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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09 899,421

07/05/2001

Alexander Klausener

Mo-6466/LeA 34,706

3351

34947

7590

03/25/2003

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EXAMINER

SHAMEEM, GOLAM M

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 03/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/899,421

Applicant(s)

KLAUSENER ET AL.

Examiner

Golam M M Shameem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 07 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

Claims 1-11 are pending in the application. Receipt is acknowledged of applicant's response to Office action of paper No. 6, filed on January 7, 2003 and that has been entered. Claims 10 and 11 are withdrawn from consideration by the Examiner under 37 C.F.R. 1.142 (b) as directed to non-elected subject matter.

### ***Response to Election/Restriction***

Applicant's election with traverse of Group I, claims 1-9 drawn to a process for preparing 2-alkyl-aryloxaziridine, is also acknowledged. The traversal is on the ground(s) that the elected Group I could be extended and examined together with "all the claims at the same time" without a serious burden on the Examiner. This argument is not found persuasive because the products of groups I to III differ materially in structure and in element from each other and, are capable of supporting their own patents. The wide disparity among the groups requires that many divergent fields must be searched, including all classes and subclasses of U.S. and foreign patents as well as journals and publications. Also, the fields of search are not coextensive. Therefore a separate search considerations are involved, which would impose a burden if unrestricted.

Further, 35 U.S.C. 121, statutory patent law, is the singular basis for the restriction. The 35 U.S.C. 121 makes clear that restriction may be required in certain applications and that the Director/Commissioner has the right to make such a determination. In addition, the applicant's nowhere present evidence to the contrary that they are claiming independent and distinct inventions.

For these reasons, applicant's arguments are found unpersuasive and, since 35 U.S.C. 101 allows one patent per invention, the requirement for restriction in Paper No. 6 is still deemed proper and is therefore made FINAL.

Applicants preserve their right to file a divisional on the non-elected subject matter.

### ***Response to Arguments***

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krimm et al (US Pat No 2,784,182) and further in view of Schirmann et al (US Pat No. 3,819,653) or Bulachkova et al (1990) of record and the rejection has been maintained for the reasons given in the last office action (paper No. 6). Applicant's arguments have been fully considered but are not deemed persuasive because Applicants' arguments unsupported by objective and competent factual evidence are entitled to little weight. *In re Greenfield* 197 USPQ 227. *In re Lindner* 173 USPQ 356. Applicant alleges, "the references do not provide a basis for the proposed modification of adding water to water-immiscible solvents" (Response, page 2). Applicant further argues, "the rejection for failure to establish a prima facie case in that the proposed combination of references would not have led to the claimed process with a reasonable expectation of success (Response, page 4).

This assessment is speculation on applicant's behalf because one of ordinary skill in the art deemed to be aware of all the pertinent art in the field. The prior art teach a generic process of preparing oxaziridines using analogous reagents such as aldehydes (column 2, line 67 of US '182), mono-peroxy phthalic acid (column 3, line 38 of US '182), water -miscible solvent e.g. chlorobenzene (column 3, line 69 of US '182), at an overlapping temperature range. The differences between the instant claims and the prior art references are so negligible, that one of

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ordinary skill in the chemical art would expect slight variations to be within the expected purview of 35 U.S.C. 103(a). The disclosure of Krimm et al and further in view of Schirmann et al or Bulachkova et al teach several combinations that would easily place Applicants' invention in possession of the public at the time of Applicants' invention was filed. The motivation to make the claimed process derives from the expectation that the use of analogous reagents under specific set of reaction conditions would have made similar products. The determination of optimum reaction conditions is routine experimentation and to one skilled in the art. Changes in temperature, concentration of reactants, or both are not patentable modification in the absence of unexpected results, which is different in kind and not degree (*In re Boesch*, 205 USPQ, 215 CCPA 1980). Since there is an exemplary teaching of a process to obtain the claimed compounds in the prior art, one would have reasonable expectation that such modification and optimization of reaction conditions would give compounds with similar rate of recovery. Only a reasonable expectation of success, not absolute predictability, is necessary for a conclusion of obviousness. *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). In the absence of objective evidence showing an unexpected result, the obviousness rejection is deemed to be proper and hence, this rejection must be maintained.

Therefore, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (703) 305-0116. The examiner can normally be reached on Monday-Thursday from 6:30 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (703) 308-4532. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592. When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy

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published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-2286.

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March 19, 2003